

REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Amendments to Claims

A typographic error in the previous amendment to claim 1 has been corrected.

2. Rejection of Claims 1-5 in view of Applicant's U.S. Patent No. 6,567,273

This rejection is respectfully traversed on the grounds that the claims of the '273 patent do not recite a communication network card that can

- “detect, judge, and support action signals” received through interfaces at opposite ends of the card, as recited in claim 1 of the present application.

To the contrary, the '273 patent claims a silicon disk (memory) card with a USB plug that merely

- “*discriminat[es] which interface is accessing said data*” and
- enables “*access to said flash memory.*”

It is respectfully submitted that discriminating which interface is accessing the data, and “enabling access to a flash memory,” is not the same as “*detecting, judging, and supporting action signals*” as claimed.

This might seem like a subtle distinction, but it is nevertheless a real one. The micro control chip of the claimed invention is an active device that not only “detects” action signals, but “judges” and “supports” them by ordering components on the circuit board to perform the requested actions. The “bridging chip” of the '273 card is simply a discriminator, and the card is a passive memory device that lacks the full functionality of the claimed micro control chip.

As to the Examiner's comments concerning extension of monopoly, it is respectfully noted that the present application was filed before the '273 patent, so it will expire earlier. The Applicant could hardly have presented claims in the '273 patent corresponding to those of the present application since the claims would not have been supported, and there was no need to

present such claims since the '273 patent issued before the earlier-filed present application had even been examined.

While the Applicant believes that the double patenting rejection is improper, the Applicant will consider filing a Terminal Disclaimer should the remaining rejections in the application be overcome.

3. Rejection of Claims 1, 2, 4, and 5 Under 35 USC §102(e) in view of U.S. Patent No. 6,694,376 (Ohara)

This rejection is respectfully traversed on the grounds that the Ohara patent fails to disclose or suggest a storage communication network card in which a first end is arranged to be inserted into a card insert slot of a first computing device, and the second end is arranged to be connected to a second computing device, the card including a micro control chip that detects, judges and executes commands supplied through *either* interface at either end, so that the card can either be connected in conventional fashion by inserting it into the PC card slot, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter.

According to the Examiner, the communication protocol device that provides the first interface at the first end corresponds to the TFTP, LRP and UDP protocols described in col. 5, line 64 to col. 6, line 10 of the Ohara patent, while the second interface at the second end corresponds to CPUs 50, 5, 6, and 11 shown in Fig. 1. This interpretation of the Ohara patent makes no sense. Element 10 shown in Fig. 1 of Ohara is a printer that includes CPU 11. Element NIC1 is a network interface controller that includes CPU 5 ("CPU 6" is actually a ROM) for managing communications between the printer 10 and the host computer ("manager G"), which has its own CPU 50. CPU 5 of the NIC transfers data sent by a "line printer remote" LPR to the printer 10, and returns the results of processing to the manager G via the LAN controller 3, transceiver 2, and network W (see col. 6, lines 10-16 of the Ohara patent). There is no suggestion that the CPU 5 of the NIC automatically orders a circuit board or other electronic

components to support an instructional action sent by either CPU 50 of the host or CPU 11 of the printer. CPU 5 merely controls the throughput of data from the host G to the printer 10. This has *nothing* to do with the claimed invention.

It is respectfully noted that the Network Interface Controller (NIC) of Ohara is clearly not inserted into an interface slot of the host computer G. To the contrary, NIC1 of Ohara communicates with the host computer through transceiver 2 via the network W, and does not communicate at all with a second host computer, but to the contrary is connected to a printer. In fact, the Ohara patent is solely directed to communications between networked host computers and printers, and not to a communications card of the type claimed.

The claimed invention is essentially a card-type peripheral device that, like other PC card-type peripheral devices is arranged to be inserted into a notebook computer PC card slot and to respond to action signals supplied through the PC card slot. Unlike other PC card-type peripheral devices, however, the second end of the device is also capable of connected to a computing device, and the peripheral device is capable of responding to action signals from *either* end. Thus, the claimed peripheral device is capable of being connected at opposite ends to different host computing devices with different types of interfaces, *i.e.*, a single peripheral that supports *two* hosts, and can be controlled by *either*. The Ohara patent does not teach this concept, but rather teaches a controller that serves as a network interface between a host computer and a printer connected to the network. While multiple “hosts” may be connected to the network W of Ohara, they all communicate with the printer through the transceiver 2, and not through dual interfaces at either end. As a result, it is respectfully submitted that the Ohara patent neither discloses nor suggests the claimed invention, and withdrawal of the rejection of claims 1, 2, 4, and 5 based on the Ohara patent is respectfully requested.

4. Rejection of Claim 3 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,694,376 (Ohara) and 6,560,099 (Chang)

This rejection is respectfully traversed on the grounds that the Chang patent, like the Ohara patent, fails to disclose or suggest a dual-interface communication network card that

includes a micro control chip arranged to execute commands supplied through *either* interface at either end, so that the card can either be connected in conventional fashion by inserting it into the PC card slot, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter.

The Chang patent discloses an interface card with two conventional IDE interfaces and two conventional USB interfaces, and a cut-over switches that allows either of the IDE interfaces to be connected to either of the USB interfaces. There is no suggestion of a micro control chip for detecting, judging, and supporting action signals received from either end, as claimed, much less configuration of the first interface to be inserted into an insert slot, as claimed. Furthermore, the interface card has nothing to do with the network printer interface controller of Ohara, and there is no possible reason, except the suggestions of Applicant's own disclosure, to combine the teachings of Ohara and Chang. As a result, it is respectfully submitted that the rejection of claim 3 under 35 USC §103 in view of the Ohara and Chang patents is improper, and withdrawal of the rejection is respectfully requested.

5. Rejection of Claims 1, 2, 4, and 5 Under 35 USC §102(e) in view of U.S. Patent No. 5,857,087 (Bemanian)

This rejection is respectfully traversed on the grounds that the Bemanian patent fails to disclose or suggest a storage communication network card in which a first end is arranged to be inserted into a card insert slot of a first computing device, and the second end is arranged to be connected to a second computing device, the card including a micro control chip that detects, judges and executes commands supplied through *either* interface at either end, so that the card can either be connected in conventional fashion by inserting it into the PC card slot, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter.

Instead, like the controller of Ohara, discussed above, the device of Bemanian is neither a network communication card designed to be inserted into the slot of a computer (such a

PCMCIA card), and clearly bears no resemblance to the peripheral products recited in claim 5. Furthermore, the interface and CPU module of Bemanian merely converts and transmits data between the respective interfaces, and does not order a circuit board or other electronic components in the card to support instructional actions in the manner claimed.

The passage of Bemanian cited by the Examiner merely states that the CPU module 36 transfers data between a P-bus interface module and network interface modules on separate processor boards. This hardly corresponds to the network communication card of the claimed invention. All of the “modules” of Bemanian are on separate cards and there is no suggestion of housing them all within a PC card. In fact, the network interface modules are connected to the CPU module by bus 84. Neither the P-bus interface nor the network interface modules of Bemanian have interfaces at either end, in the claimed manner. As a result, it is respectfully submitted that the Bemanian patent, which is directed to distributed communications modules and not to a double interface communications card of the type claimed, does not anticipate any of claims 1, 2, 4, and 5, and withdrawal of the rejection under 35 USC §102(e) in view of the Bemanian patent is respectfully requested.

6. Rejection of Claim 3 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,694,376 (Ohara) and 6,560,099 (Chang)

This rejection is respectfully traversed on the grounds that the Chang patent, like the Bemanian patent and as discussed above, fails to disclose or suggest a dual-interface communication network card that includes a micro control chip arranged to execute commands supplied through *either* interface at either end, so that the card can either be connected in conventional fashion by inserting it into the PC card slot, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter. Instead, as noted above, the Chang patent discloses an interface card with two conventional IDE interfaces and two conventional USB interfaces, and a cut-over switches that allows either of the IDE interfaces to be connected to either of the USB interfaces. As a result, it is respectfully submitted that the rejection of claim 3 under 35 USC §103 in view

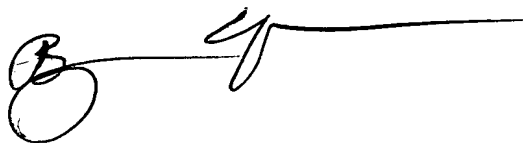
S.N. 09/929,353

of the Bemanian and Chang patents is improper, and withdrawal of the rejection of claim 3 under 35 USC §103(a) is respectfully requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to be 'B. Urcia', with a long horizontal line extending to the right.

By: BENJAMIN E. URCIA
Registration No. 33,805

Date: November 4, 2004

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314

Telephone: (703) 683-0500

NWB:S:\Product\bu\Pending 1...PJ\LIU 929353w02.wpd